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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/725,023 01/07/97 HESS

H ESLOT-0228

IM31/0819

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EXAMINER

MACKEY, J

ART UNIT

PAPER NUMBER

1722

DATE MAILED:

08/19/98

**Please find below and/or attached an Office communication concerning this application or proceeding:**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/725,023**

Applicant(s)  
**HESS ET AL.**

Examiner  
**James P. Mackey**

Group Art Unit  
**1722**



☒ Responsive to communication(s) filed on May 26, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-13 is/are pending in the application.

Of the above, claim(s) 5-13 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-4 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4, 7

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1722

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Note that Applicant appears to be entitled to a filing date of Oct. 2, 1996 for the instant application (since a foreign language description, claim, drawings and an identification of all inventors were filed on that date); Applicant should petition the Office to accord such a filing date in order to be granted priority to both of the priority applications submitted.

2. Applicant's election with traverse of Group I, claims 1-9 in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the claimed process requires the particulars of the claimed apparatus since the process claim depends from the apparatus claim 1. This is not found persuasive because the apparatus can be used to practice another and materially different process, such as a process in which a single filling operation is carried out for the single compacting of a single layer of a non-concrete material such as ceramic particles; the argument regarding payment of royalties presumes that infringement of the apparatus claims would necessarily constitute infringement of the process claims, which is an unwarranted presumption in view of the distinctness of the two inventions as claimed.

The requirement is still deemed proper and is therefore made FINAL.

3. Claims 10-13 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention, the requirement having been traversed in Paper No. 6.

Art Unit: 1722

4. Applicant's election of Species I, claims 1-4 in Paper No. 9 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
5. Claims 5-9 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected species. Election was made **without** traverse in Paper No. 9.
6. Applicant should provide appropriate headings for the instant specification. The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

The following order or arrangement is preferred in framing the specification and, except for the reference to "Microfiche Appendix" and the drawings, each of the lettered items should appear in upper case, without underlining or bold type, as section headings. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) Title of the Invention.
- (b) Cross-References to Related Applications.
- (c) Statement Regarding Federally Sponsored Research or Development.
- (d) Reference to a "Microfiche Appendix" (see 37 CFR 1.96).
- (e) Background of the Invention.
  1. Field of the Invention.
  2. Description of the Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) Brief Summary of the Invention.
- (g) Brief Description of the Several Views of the Drawing(s).
- (h) Detailed Description of the Invention.
- (i) Claim or Claims (commencing on a separate sheet).
- (j) Abstract of the Disclosure (commencing on a separate sheet).
- (k) Drawings.
- (l) Sequence Listing (see 37 CFR 1.821-1.825).

Art Unit: 1722

7. The disclosure is objected to because of the following informalities: the specification should not refer to the claims by number (note page 2, lines 21-22), since the original claim numbering may not be preserved in any patent which may issue from the instant application; and the apparent incorrect recitation “diaphragm 13 [sic]” on page 8, line 32 should be corrected.

Appropriate correction is required.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-4 are incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the interrelationships between the bottom mold part, the top mold part, the load plate, the die (or the plural dies), the bottom die parts, the pressure-exerting plates, the stops, the die shanks and the pressure-medium chamber (or chambers).

Further in claim 1, lines 4-5, “the bottom die parts” lacks proper antecedent basis; line 5, the parenthetical expression is improper for the claims; and lines 9-10, “can be forced downwards under the action of a pressure medium” is indefinite in that it recites a function without setting forth structure capable of performing the function.

Art Unit: 1722

In claim 2, line 4, "the relevant bottom die part" is indefinite and unclear as to exactly what is intended to be claimed (especially considering that the claims do not apparently require plural bottom die parts); and lines 4-5, the use of "e.g." renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

In claim 3, line 2, "the dies" is indefinite since the claims do not apparently require plural dies; lines 3-4, "movable pressure-exerting plates" is indefinite as to whether these are the same as the plates in the parenthetical expression of claim 1, and indefinite as to how these plates relate to the other structural elements; and line 5, "the bottom region of the dies" lacks proper antecedent basis and is unclear as to exactly where this "region" is located.

In claim 4, line 2, "the die shanks" lacks proper antecedent basis; and line 6, "their compressive forces" lacks proper antecedent basis.

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

11. Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Baird et al. (U.S. Patent 4,753,160; Figures 5 and 6).

Art Unit: 1722

12. Claim 1 is rejected under 35 U.S.C. 102(e) as being clearly anticipated by Casolari (U.S. Patent 5,599,566; Figure 1).

13. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sigerist (U.S. Patent 4,614,488; Figures 2 and 3).

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buhler et al. (U.S. Patent 4,788,023; Figure 3) taken together with Baird et al. (U.S. Patent 4,753,160; Figures 5 and 6), Yamato (U.S. Patent 4,576,092), Casolari (U.S. Patent 5,599,566; Figure 1) and Sigerist (U.S. Patent 4,614,488; Figures 2 and 3).

Art Unit: 1722

Buhler et al. teach a press mold comprising a bottom mold part with a mold chamber, and a top mold part with a load plate and a bottom die part which is vertically movable in a displacement range defined by stops, except for a pressure chamber for exerting a pressing force on the bottom die part of the top mold part. Each of Baird et al., Yamato, Casolari and Sigerist teaches a press mold including a pressure chamber for exerting a pressing force on a displaceable die part. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Buhler et al. by providing a pressure chamber for exerting a pressing force on the die part, as disclosed in any one of Baird et al., Yamato, Casolari and Sigerist, in order to achieve uniform pressing of the material in the die. It would have been further obvious to have provided the pressure medium as compressed air, since such is a notoriously well known fluid for use as a pressure medium, and obvious to have provided the pressure chamber in any desired location for acting upon the bottom die part, since it has generally been recognized that to shift location of parts when the operation of the device is not otherwise changed is within the level of ordinary skill in the art, *In re Japikse*, 86 USPQ 70; *In re Gazda*, 104 USPQ 400.

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Mackey whose telephone number is (703) 308-1195. The examiner can normally be reached on Monday-Friday from 8:30AM to 6:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan, can be reached at (703) 308-2383. The fax phone number for this Group is (703) 305-7718.



Serial Number: 08/725,023

Page 8

Art Unit: 1722

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

MACKEY/jpm  
August 15, 1998

*James Mackey*  
**JAMES MACKEY**  
**PRIMARY EXAMINER**  
**ART UNIT 1722**

*8/17/98*